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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,372	09/19/2003	Marc Holness	NOR-034 (15632RO)	8497

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EXAMINER	
ABELSON, RONALD B	

ART UNIT	PAPER NUMBER
2619	

MAIL DATE	DELIVERY MODE
11/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/666,372	HOLNESS ET AL.	
	Examiner	Art Unit	
	Ronald Abelson	2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-13,16,19 and 22-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *11-13,16,19 and 22-24* is/are allowed.

6)☒ Claim(s) *1-9 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Ron Abelson

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/2/05 and 9/19/03* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Objections

1. Claims 4 and 5 is objected to because of the following informalities: The term "PRM" of claim 4 and "PRMs" of claim 5 are not defined. The examiner assumes the term refers to a performance report message. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-9 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/741,909 '909'. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claim 1, '909' teaches generating a service performance report message at each of the service termination points (measuring performance at first network element, claim 1 lines 5-6, measuring performance at second network element, claim 1 lines 9-11), each service performance report message having service-specific information related to a performance of the service as determined by the service termination point generating that service performance report message (claim 1 lines 5-6, 9-16), and

transmitting the service performance report message generated by one of the service termination points to the other service termination point over a service management channel (claim 2) to enable an assessment of the performance of the service based on

the service performance report messages from both service termination points (col. 1 lines 12-16).

Although '909' does not explicitly teach each service performance report message identifying the service to which the service-specific information in that service performance report message pertains, it would have been obvious to one of ordinary skill in the art, to modify the system of '909' by identifying the service to which the service report pertains. This modification would benefit the system by ensuring that when performing the step of correlation (claim 1 lines 12-16), the correlation is done on the same type of information.

In determining the appropriate standard for obviousness the Supreme Court in KSR International Co. v. Teleflex Inc. et al, 550 U.S._____(2007) reaffirmed the standard of review under Graham v. Deere 383 U.S. 1, 148 USPQ 459 (1966). It held that the standard of teaching, suggestion, or motivation (TSM) was appropriate. But it also held that obviousness is not strictly limited to the TSM requirements. One must consider the totality of the art from the point of view of a skilled artisan. Thus, the fact that a reference teaches one way of doing something does not preclude a finding of obviousness

when items are combined for a different function. The Court specifically stated that "if a person of ordinary skill in the art can implement a predictable variation, Section 103 likely bars its patentability." While the court stated that mere conclusory statements is an insufficient reason to combine known elements, it stated that "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account of the inferences and creative steps that a person of ordinary skill in the art would employ." This evaluation includes the use of common sense and whether the combination of familiar elements according to known methods yields predictable results.

Claims 3-9 and 25 are rejected based upon patent '909' in view of KSR given the limitations of the dependent claims are not novel.

4. Claim 2 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being

unpatentable over claim 2 of copending Application No. 10/741,909 '909' in view of 10/741,909 claim 3.

This is a provisional obviousness-type double patenting rejection.

Claim 2 of '909' is silent on monitoring the service management channel from an intermediate network element that is in the dedicated circuit between the service termination points to determine a status of the service.

Claim 3 of '909' teaches monitoring the service management channel from an intermediate network element that is in the dedicated circuit between the service termination points to determine a status of the service.

Therefore it would have been obvious to one of ordinary skill in the art, to modify the system of '909' claim 2 by monitoring the service management channel from an intermediate network element that is in the dedicated circuit between the service termination points to determine a status of the service, as shown by '909' claim 3. This modification can be performed according to the teachings of xxx. This modification would benefit the system by allowing the intermediate nodes to react based upon the received service management messages.

Allowable Subject Matter

5. Claims 19, 11-13, 16, and 22-24 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 1-9 and 25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Abelson whose telephone number is (571) 272-3165. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7439. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RA

Ronald Abelson
Examiner
Art Unit 2619

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